

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. CAREY and JOSEPH H. EDWARDS

Appeal No. 1999-2537
Application No. 08/619,269

ON BRIEF

Before FRANKFORT, NASE, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 4, 5, 7, 9, 11, 12, 15 to 18, 22, 23 and 25 to 27.¹ Claim 24 has been allowed. Claims 10, 19 and 20 have been withdrawn from consideration under 37 CFR § 1.142(b)

¹ Claims 9, 12 and 16 were amended subsequent to the final rejection.

Appeal No. 1999-2537
Application No. 08/619,269

as being drawn to a nonelected invention. Claims 1 to 3, 6,
8, 13, 14 and 21 have been canceled.

We AFFIRM.

BACKGROUND

The appellants' invention relates to an article of clothing to be worn about the head (specification, p. 1). A substantially correct copy of the claims under appeal is set forth in the appendix to the appellants' brief. An understanding of the invention can be derived from a reading of exemplary claim 22 which is reproduced below.

22. An article of clothing to be worn on the head of a user and adapted for use with sport goggles which have a height and width, said article of clothing comprising:

a mask member formed of a first material that is insulative and wind-resistant, said mask member being sized to snugly cover a portion of the face of a user and said mask member having a middle edge for positioning above the mouth and below the nose of a user, a perimeter which includes an upper edge for positioning under the eyes of a user and a lower edge for positioning below the mouth of a user;

a head member formed of a second material different from said first material, said second material being closely woven and elastically deformable, said head member being sized to substantially enclose the head of a user and fixedly connected to said mask member along at least a portion of said perimeter of said mask member excluding said upper edge, said head member and said mask member together being sized to completely surround the head of a user, and said head member having a head edge for positioning above the eyes of a user;

an eye opening formed to register with the eyes of a user, said eye opening being defined by said head edge spaced from said upper edge of said mask member a height less than the height of protective sport goggles; and

a scarf portion unitarily formed to be an extension of said head member for extending downwardly from said

head member to be positionable around and proximate the neck of a user, said scarf portion being fixedly connected to said mask member along a portion of said perimeter of said mask member excluding said upper edge.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|---------------------------------|-----------|----------|
| Ensten 1936 | 2,039,478 | May 5, |
| Reisen 1973 | 3,725,956 | Apr. 10, |
| Carey et al. 1993 (Carey) | 5,214,804 | June 1, |

Claims 4, 5, 7, 9, 11, 12, 15 to 18, 22, 23 and 25 to 27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 4, 5, 7, 9, 11, 12, 15 to 18, 22, 23 and 25 to 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Carey in view of Ensten and Reisen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 18, mailed August 1, 1997) and the answer (Paper No. 28, mailed August 17, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 27, filed June 26, 1998) and reply brief (Paper No. 29, filed October 19, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In accordance with 37 CFR § 1.192(c)(7), we have selected claim 22 as the representative claim from the appellants' grouping of claims 4, 5, 7, 9, 11, 12, 15 to 18, 22, 23 and 25

to 27 to decide the appeal on each of the above-noted rejections. See page 3 of the appellants' brief.

The indefiniteness issue

We will not sustain the rejection of claims 4, 5, 7, 9, 11, 12, 15 to 18, 22, 23 and 25 to 27 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C.

§ 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, the appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we analyze the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claim 22. The examiner determined (answer, p. 4) that the term "the height of protective sport goggles" is indefinite because sport goggles are manufactured in a variety of different heights.

We agree with the appellants (brief, pp. 3-7, and reply brief, pp. 2-3) that claim 22 is not indefinite. Specifically, we agree with the appellants that the mere breadth of claim 22 does not in and of itself make claim 22 indefinite.² Additionally, we believe that claim 22 when read in light of the second full paragraph of page 9 of the specification defines the metes and bounds of the claimed invention with a reasonable degree of precision and particularity. In that regard, it is our view that broadest reasonable interpretation consistent with the specification³

² Breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

³ See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023,
(continued...)

of the term "the height of protective sport goggles" is that the height of the eye opening is less than the tallest height of sport goggles.

We also agree with the appellants that the other independent claims on appeal (i.e., claims 23, 25, 26 and 27) are not indefinite for the reasons set forth above with respect to claim 22.

For the reasons set forth above, the decision of the examiner to reject claims 4, 5, 7, 9, 11, 12, 15 to 18, 22, 23 and 25 to 27 under 35 U.S.C. § 112, second paragraph, is reversed

The obviousness issue

We sustain the rejection of claims 4, 5, 7, 9, 11, 12, 15 to 18, 22, 23 and 25 to 27 under 35 U.S.C. § 103.

³(...continued)
1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Carey discloses an article of clothing 10 including a protective mask 12 with a scarf 14 combined therewith. As shown in Figure 2, the mask member 12 is sized and shaped to fit about the face and has an upper edge which extends along the lower part of the eye socket areas of the user and contouredly over the nose. The mask member also has a lower edge which extends under the chin and upwardly toward the upper edge on both sides of the face rearward of the eye socket areas. The scarf member 14 is secured to the mask member along the lower edge. The scarf member is sized to extend downwardly from the lower edge substantially the height

of the neck. The scarf member extends in width rearwardly about the neck on both sides of the head. Securing means are associated with the scarf member to secure the article of clothing about the head of the user and preferably behind the head of the user. As shown in Figure 1, the mask member 12 includes a middle edge 68 formed under the nose of the user. Carey teaches (column 2, lines 4-12, and column 5, lines 17-28) that the mask member 12 is preferably a closed-cell neoprene with an internal fleece layer laminated thereto and an external water-resistant material (e.g., LYCRA™) is also laminated thereto. Carey also teaches (column 2, lines 13-16, and column 4, lines 42-55) that the scarf member is desirably made of a soft, stretchable material, preferably, the scarf member is made of fleece-like material such as POLAR TEC™. As shown in Figure 2, the article of clothing 10 is positioned about the user's head 78 which is shown in phantom. A cap 80 is positioned about the head 78 along with goggles 82 which have a strap 84 extending rearwardly about the head 78. Carey teaches (column 5, lines 60-63) that the lower portion of the goggles 82 is cut away and not shown and that the cut away

portion fits over the top 79 of the mask member 12 and more specifically over an upper edge 16 of the mask member.

Ensten discloses a knitted article of headwear which covers the head, neck and lower portion of the face of the face, leaving the eyes and nose of the user exposed as shown in Figure 1. The headwear includes a crown or skull covering portion 1 and lower portion 2 which constitutes a neck piece and face-cover portion.

In applying the above-noted test for obviousness, we reach the conclusion that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to extend the scarf member of Carey to cover the crown or skull of the user as suggested by the headwear of Ensten for the self-evident advantages thereof (e.g., no need for a separate cap).⁴

⁴ We regard the examiner's application of the teachings of Reisen to be mere surplusage since Carey's scarf member is made of closely woven and elastically deformable material (i.e., a fleece-like material such as POLAR TEC™).

The arguments advanced by the appellants (brief, pp. 8-11, and reply brief, pp. 3-5) are unpersuasive for the following reasons. First, the appellants have argued deficiencies of each reference on an individual basis, however, it is well-settled that nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Secondly, we note that all of the features of the secondary reference need not be bodily incorporated into the primary reference (see In re Keller, supra, at 642 F.2d 425, 208 USPQ 881) and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (see Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)). Lastly, we note that while there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination (see B.F. Goodrich Co. v.

Aircraft Braking Systems Corp., 72 F.3d 1577, 1583, 37 USPQ2d 1314, 1319 (Fed. Cir. 1996) and In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)) as the appellants would apparently have us believe. Rather, as stated above, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In this case, it is our opinion that the combined teachings of Carey and Ensten would have made it obvious at the time the invention was made to a person having ordinary skill in the art to arrive at the subject matter of claim 22 for the reasons set forth above.

For the reasons set forth above, the decision of the examiner to reject claim 22 under 35 U.S.C. § 103 is affirmed. In accordance with 37 CFR § 1.192(c)(7), claims 4, 5, 7, 9,

11, 12, 15 to 18, 23 and 25 to 27 fall with claim 22. Thus, it follows that the decision of the examiner to reject claims 4, 5, 7, 9, 11, 12, 15 to 18, 23 and 25 to 27 under 35 U.S.C. § 103 is also affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 4, 5, 7, 9, 11, 12, 15 to 18, 22, 23 and 25 to 27 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 4, 5, 7, 9, 11, 12, 15 to 18, 22, 23 and 25 to 27 under 35 U.S.C. § 103 is affirmed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

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| CHARLES E. FRANKFORT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JEFFREY V. NASE |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| JOHN F. GONZALES |) | |
| Administrative Patent Judge |) | |

Appeal No. 1999-2537
Application No. 08/619,269

Page 17

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APPEAL NO. 1999-2537 - JUDGE NASE
APPLICATION NO. 08/619,269

APJ NASE

APJ GONZALES

APJ FRANKFORT

DECISION: **AFFIRMED**

Prepared By: Gloria Henderson

DRAFT TYPED: Feb 10, 2000

FINAL TYPED: